



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/535,422

12/19/2005

Daisuke Kuroda

050316

6152

23850 7590 11/02/2009  
KRATZ, QUINTOS & HANSON, LLP  
1420 K Street, N.W.  
Suite 400  
WASHINGTON, DC 20005

EXAMINER

ZHU, WEIPING

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

11/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,422	<b>Applicant(s)</b> KURODA ET AL.	
	<b>Examiner</b> WEIPING ZHU	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-14, 16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-14, 16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-7, 11-14, 16 and 18 are currently under examination, wherein claims 1 and 3 have been amended in applicant's amendment filed on July 16, 2009. Claims 8, 15 and 20 have been cancelled in the same amendment.

### ***Status of Previous Rejections***

2. The previous rejections of claims 1-7, 11-14, 16 and 18 under 35 U.S.C. 103(a) as stated in the Office action dated March 24, 2009 are maintained as follows.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 11-14, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berns (US 5,503,687) in view of Wikipedia ([http://en.wikipedia.org/wiki/Stainless\\_steel](http://en.wikipedia.org/wiki/Stainless_steel)) and further in view of Gordon (US Pub. 2002/0133225 A1) as stated in the Office action dated March 24, 2009.

With respect to the amended feature in claim 1, Berns ('687) discloses that the nitrogen treated stainless steel has a two-phase structure of ferrite and austenite or a one phase austenitic structure (Berns ('687), col. 1, lines 49-56). Furthermore, it has been well held where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially

Art Unit: 1793

identical processes; a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), MPEP 2112.01 [R-3] I. In the instant case, the claimed and Berns ('687) in view of Wikipedia and further in view of Gordon ('225 A1)'s stents are identical or substantially identical in structure or composition and are produced by identical or substantially identical processes as discussed in the Office action dated March 24, 2009, therefore a prima facie case of obviousness exists. The same final microstructure as claimed in the instant claim 1 would be expected in the stent of Berns ('687) in view of Wikipedia and further in view of Gordon ('225 A1) as in the claimed stent.

With respect to the amended feature in claim 3, it does not change the scope of the claim. Therefore, the reason for the rejection of claim 3 as stated in the Office action dated March 24, 2009 is further applied herein properly.

### ***Response to Arguments***

4. The applicant's arguments filed on May 30, 2008 have been fully considered but they are not persuasive.

First, the applicant argues that Wikipedia reference is not a proper reference. In response, the examiner notes that the well-known compositions of the ferritic stainless steel as disclosed in Wikipedia upon which the rejection of the claimed ferritic stainless steel relies is actually quoted from the reference 14, which is published in 1996.

Second, the applicant argues that Berns ('687) only discloses that portions in the surface zone are converted to austenite. In response, see the reason for the rejection of the claimed final microstructure above.

Third, the applicant argues that the material disclosed in Gordon ('225 A1) may include Ni. In response, the examiner notes that Gordon ('225 A1) discloses a ferritic stainless steel stent (paragraph [0057]). Both the ferritic stainless steel of Gordon ('225 A1) and the nitrogen treated ferritic stainless steel of Berns ('687) in view of Wikipedia would have very little nickel as disclosed by Wikipedia.

Fourth, the applicant argues that the basis for material selection in Gordon ('225 A1) is completely different from that in Berns ('687). In response, the examiner notes that both Gordon ('225 A1) and Berns ('687) select the ferritic stainless steel. The combination of Gordon ('225 A1) and Berns ('687) is proper and maintained. The basis for material selection do not have to be the same between Gordon ('225 A1) and Berns ('687).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1793

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

WZ

9/4/2009